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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,153	02/01/2001	Katsuhiko Torii	2842.02US01	1357

7590 05/30/2002

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[REDACTED] PAPER NUMBER

3682

DATE MAILED: 05/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/762,153	TORII ET AL.
	Examiner	Art Unit
	William C. Joyce	3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 01 February 2001.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 21-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 21-28,30-36,38-46,50 and 52 is/are rejected.
- 7) Claim(s) 29,37,47-49 and 51 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

This is the first office action in response to the above identified patent application filed on February 01, 2001.

#### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract of the disclosure is objected to because the implied phrase "is disclosed" (line 1) must be removed. Correction is required. See MPEP § 608.01(b).

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 28, 36, and 50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
- a. Claim 28, line 3, the limitation "the ball" lacks proper antecedent basis.
  - b. Claim 36, line 3, the limitation "the ball" lacks proper antecedent basis.
  - c. Claim 50, line 3, the limitation "the ball" lacks proper antecedent basis.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 21-26, 31-34, 39-41, 43-46 are rejected under 35 U.S.C. 102(b) as being anticipated by Profet (3,559,499).

Profet discloses a mechanical actuator comprising a motor (14), an output unit (22, 24) coupled to the motor, the output unit having a worm gear drive (74, 76) for transmitting rotation of the motor to the driven device, a housing (12, 66) for accommodating the worm drive, a clutch (38, 54, 56) located between the rotating shaft of the motor and the worm drive, wherein the clutch allows the transmission of rotation from the motor to the worm drive and blocks transmission from the worm drive to the motor, and wherein the clutch has a clutch housing (12) fixed to the unit housing, and

an engaging mechanism located between the unit housing and the clutch housing for blocking rotation of the clutch housing relative to the unit housing.

The clutch comprising a driving rotor (38) coupled to the motor, a driven rotor (54) coupled to a worm shaft of the worm drive, a lock member (56) for selectively allowing and blocking the rotation of the driven rotor.

With respect to claim 23, Profet does not show a bearing attached to the clutch housing (12) for supporting the rotating shaft of the motor, but it is understood that the motor is configured with bearings for supporting the rotating shaft. Accordingly, the bearings supporting the rotating shaft are attached to the clutch housing inasmuch as applicant's bearing illustrated in Figure 1 is attached to the clutch housing.

#### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 27, 30, 35, 38, 42, 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Profet (US Patent 3,559,499) as applied to claims 21, 26, 31, 34, 39, and 41 above.

With respect to claims 27, 35, and 42, Profet does not illustrate the driven rotor formed integrally with the worm shaft, but shows the driven rotor and the worm shaft formed as separate components. It would have been obvious to one of ordinary skill in

the art at the time the invention was made to form the driven rotor and the worm shaft of Profet as a single component, since it has been held that forming in one piece an article which has formerly been made in two pieces and put together involves only routine skill in the art.

With respect to claims 30, 38, and 52, Profet does not disclose the actuator being used for moving a windowpane, but discloses that the actuator is used to move a load. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the actuator of Profet for opening and closing a windowpane, motivation being to provide a mechanized device for efficiently and securely moving a windowpane to a predetermined position.

#### ***Allowable Subject Matter***

10. Claims 28, 36, and 50 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

11. Claims 29, 37, 47-49, and 51 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note the actuator having a clutch of Lucht ('788), Ochtman ('019), and Opyrchal ('066).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Joyce whose telephone number is (703) 305-5114. The examiner can normally be reached on Monday - Thursday 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci can be reached on (703) 308-3668. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

*William Joyce 3682*  
William C. Joyce  
May 28, 2002